

REMARKS

This is in response to the Office Action mailed on June 17, 2004, and the references cited therewith.

No claims are amended, claims 39-49 remain canceled, and claims 60-63 are added; as a result, claims 1-33 and 50-63 are now pending in this application.

The new claims have support throughout the specification. No new matter has been added as a result.

In a phone message to Applicant's Representative from the Examiner on August 27, 2004 (in response to a phone message from Applicant's Representative to the Examiner), the Examiner clarified that no Declaration is needed to provide documentation to support common ownership of the present invention and the Lange reference, as was requested on page 6 of the Office Action mailed on June 17, 2004. The Applicant thanks the Examiner for this clarification.

§112 Rejection of the Claims

Claims 1-33 were rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Office Action states that the amended language in claims 1, 5, 16 and 22 is new matter because the Specification uses the phrase "does not require" while the amended claims use the phrase "does not contain." The Office Action states that the phrase "does not require" means that the element is not necessary but can be present, while the Specification does not state an embodiment in which any elastic materials or fibers must not be present, which is implied by "does not contain." The Office Action concludes that the term "does not contain" is not equivalent to "does not require."

Applicant again does not admit that Lange is prior art and reserves the right to swear behind it at a later date. Nevertheless, Applicant respectfully submits that the claims are distinguishable over Lange for the reasons argued below.

Applicant respectfully submits that the Specification does provide support for an embodiment which "does not contain" elastic materials or fibers between the at least two outer layers as recited in the claims. Such an embodiment is clearly understood in the language "does

not require" as well as throughout the Specification, including on page 21, and in the figures, none of which show elastic between the at least two outer layers, such as between the two bi-layers 104A and 104B. (See, for example FIG. 3, described in the Specification, including on page 21, lines 13-21).

If a particular element is *not required*, as stated in the Specification, then the *option* to either use this element or not use this element is clearly implied. It is not necessary for the Specification to affirmatively state that elastic materials or fibers between the at least two outer layers must not be present when it is implicitly understood from the language and figures that, in one embodiment, elastic materials or fibers are not present between the at least two outer layers. Lack of literal basis in the specification for a negative limitation does not, in and of itself, establish a *prima facie* case for lack of descriptive support under the first paragraph of 35 USC 112. See *Ex parte Parks*, 30 USPQ2d 1234, 1236 (BPAI 1993).

Additionally, according to MPEP 2173.05(i), if alternative elements are positively recited in the Specification, any negative limitation or exclusionary proviso may be explicitly excluded in the claims. See also *In re Johnson*, 558 F2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977). The Specification positively recites such alternative elements, including in the last portion of the following paragraph from page 21, lines 13-20 of the Specification, which is discussing the combining of the two bi-layers or facings 104A and 104B shown in FIG. 3:

"However, unlike the material in [Lange] 09/751,239, the material of the present invention does not require the use of any type of elastic material or fibers to produce the soft, tufted product, relying instead on the internally tufted orientation of the layers."

Page 21 of the Specification continues by stating, "As noted previously, however, elastic materials or fibers *can* be used [between the at least two outer layers] in the present invention *as desired.*" This language further emphasizes that the use of elastic materials or fibers between the at least two outer layers is optional in the present invention. Therefore, it follows that in one embodiment the laminate contains elastic materials or fibers and in one embodiment the laminate does not contain elastic materials or fibers between the at least two outer layers. Applicant has chosen to recite claims directed to the latter option.

It is important to note that the use of an elastic layer elsewhere is also an option, as the Specification also states on page 16, lines 25-27 that, "In one embodiment there is an additional elastic or non-elastic layer located adjacent to [the tufted layer(s)] or between the tufted layer(s) and any adjacent layer."

Applicant's disclosure contains sufficient teaching regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and to use the claimed invention.

Reconsideration and withdrawal of this rejection is respectfully requested.

§103 Rejection of the Claims

Claims 50-59 were rejected under 35 USC § 103(a) as being unpatentable over Lange et al. (US 2002/0127937 A1).

Applicant again respectfully submits that Lange is not prior art with respect to the present application. A reference asserted under 102(e), (f), or (g) that was commonly owned with an application at the time the invention was made, cannot preclude patentability under 35 U.S.C. 103 of the claims of the application when the application was filed on or after November 29, 1999. *35 U.S.C. 103(c); 1233 OG 55 (April 11, 2000)*. The present application was filed on December 17, 2001 (as was shown by the copy of the Filing Receipt provided with the Amendment and Response filed on March 30, 2004), which is after November 29, 1999. Lange and the present application were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. Thus, Lange is commonly owned with the present application and is not prior art with respect to all pending claims of the present application.

Although the Examiner initially requested a Declaration to provide documentation to support common ownership, in response to Applicant's query as to the basis for such a request, the Examiner has now withdrawn this request.

Therefore, the Applicant respectfully requests withdrawal of the rejection under 35 USC 103(a) and reconsideration and allowance of claims 50-59.



21:19

5152339065

BARBARA CLARK

PAGE 03

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 10/021,867
Date: December 17, 2001
Title: INTERNALLY-TUFTED LAMINATES

Page 11
Dkt: 1443.009US1

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 515-233-3865 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

THOMAS J. KOPACZ ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
515-233-3865

Date SEPTEMBER 16, 2004 By Barbara J. Clark
Barbara J. Clark
Reg. No. 38,107

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16 day of September, 2004.

Gina M. Uphus

Name

Gina M. Uphus

Signature